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REPLY UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 1626

PATENT
3273-0153P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Yasutaka ISHII et al. Conf.: 1456

Appl. No.: 10/092,554 Group: 1626

Filed: March 8, 2002 Examiner: TSANG

For: CATALYST COMPRISING A CYCLIC IMIDE
COMPOUND AND PROCESS FOR PRODUCING
ORGANIC COMPOUNDS USING THE CATALYST

LARGE ENTITY TRANSMITTAL FORM
FOR REPLY AFTER FINAL UNDER 37 C.F.R. § 1.116

MS AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 22, 2004

Sir:

Transmitted herewith is an Interview Summary in the above-identified application.

- The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.
- The enclosed document is being transmitted via facsimile.

The fee has been calculated as shown below:

| | CLAIMS REMAINING AFTER AMENDMENT | HIGHEST NUMBER PREVIOUSLY PAID FOR | | | PRESENT EXTRA | RATE | ADDITIONAL FEE |
|---|---|---|----|---|------------------|--------|-------------------|
| TOTAL | 11 | - | 20 | = | 0 | \$ 18 | \$0.00 |
| INDEPENDENT | 2 | - | 3 | = | 0 | \$ 86 | \$0.00 |
| <input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM | | | | | \$290 | \$0.00 | |
| | | | | | TOTAL | \$0.00 | |

- Petition for () month(s) extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). \$0.00 for the extension of time.
- No fee is required.
- Check(s) in the amount of \$0.00 is(are) enclosed.
- Please charge Deposit Account No. 02-2448 in the amount of \$0.00. This form is submitted in triplicate.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
for Raymond C. Stewart, #21,066

RCS/RG/csm
3273-0153P

P.O. Box 747
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Attachment(s)

(Rev. 02/08/2004)



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INTERVIEW SUMMARY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 22, 2004

Sir:

On 21 September 2004, Applicants' representative Richard Gallagher conducted a telephonic interview with Examiner Tsang. The following points were made by Applicants' representative, with the Examiner's response to each indicated.

DOUBLE PATENTING.

Claims 3 and 4 were rejected on the ground of obviousness-type double patenting over claims 4 and 7-9 of US 6,232,258 B1.

NO CONFLICT IN SUBJECT MATTER. The claims in question require an SP of less than or equal to $26 \text{ (MPa)}^{1/2}$. This clearly distinguishes the compounds of the present claims from the compounds of US 6,232,258 B1.

NO COMMON OWNERSHIP. Double patenting rejections are appropriate only for “commonly **owned**” applications and patents. MPEP 706.02(l)(1). However, common **ownership** does not exist in the present situation, because US 6,232,258 B1 is owned by the entity ‘Daicel Chemical Industries, Ltd. along with Yasutaka Ishii’, while the present application is owned by the different entity ‘Daicel Chemical Industries, Ltd’.

Each of these reasons alone provides sufficient basis for withdrawal of the double patenting rejection, which action is respectfully solicited.

The Examiner indicated that he would reconsider whether there was in fact any conflict in the subject matter. However, he indicated that if he remains unconvinced that there is no conflict in subject matter, “one person cannot have two patents on a single invention” and that therefore he would maintain the double patenting rejection.

FORMULAS: METHYLS.

Claim 1 refers to a Formula (I) – that is, Roman numeral “I”. Claim 2 refers to a Formula (1) – that is, Arabic numeral “1”.

The two lines on the lefthand side of Formula (I) are not used by Applicants to designate methyl groups. Instead they are bonds (open valences). Formula (1) in claim 2 describes preferred groups that can satisfy the open valences of Formula (I) in claim 1.

The Examiner indicated that regardless of Applicants' intention, the two lines on the lefthand side of Formula (I) look like methyl groups. Formula (I) should be amended to replace the lines with variables such as R^a and R^b. However, any such change must have support in the specification. Alternatively, Applicants may drop Formula (I) in favor of Formula (1).

FORMULAS: MULTIPLE SUBSTITUENTS.

The substituent designation {R^xO-C(=O)}_n- means that the benz ring in Formula (II) may carry 1, 2, 3, or 4 substituent groups of the formula R^xO-C(=O)-. When the benz ring carries 2, 3, or 4 of those substituent groups, the 2, 3, or 4 groups can be the same or different.

The Examiner indicated that since there is only one bond extending into the benz ring, Formula (II) is confusing. Applicants should consider deleting the substituent from the formula and rewriting the text after the formula to read something like: "wherein said cyclic imide is substituted in

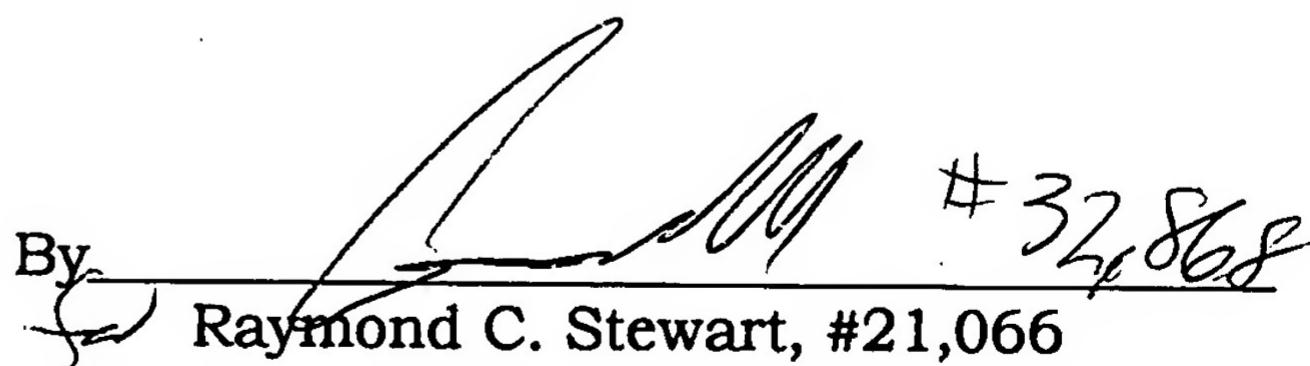
the 3-, 4-, 5-, and/or 6-position by a group of the formula $-C(=O)-OR^x$ wherein R^x is a hydrocarbon group having five or more carbon atoms and wherein R^x may be the same or different when said cyclic imide is substituted by more than one said group". This should also take care of the problems with dependent claims 13 and 14

Should there be any outstanding issues that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at (703) 205-8008.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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